

**REMARKS**

The present amendment is in response to the Office Action dated February 6, 2008, where the Examiner has rejected claims 36-63. In the present amendment, claims 36, 38, 45, 56 and 63 have been amended. Accordingly, claims 36-63 are pending in the present application with claims 36, 38, 45, 56, and 63 being the independent claims. Reconsideration and allowance of pending claims 36-63 in view of the amendments and the following remarks are respectfully requested.

A. Rejection of Claims 36-43, 44-45, 56-62 and 63 Under 35 U.S.C. 103

Claims 36-43, 44-45, 56-62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,198,390 issued to Schlager ("Schlager") in view of US Patent Number 6,091,956 issued to Hollenberg ("Hollenberg"), in view of US Patent Application Publication No. 2002/0087401 issued to Leapman ("Leapman") and further in view of US Patent Number 6,947,976 issued to Devitt ("Devitt").

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

### 1. Suggestion or Motivation to Combine

Combining the references will be moot in light of the amendment to the claim 36. For example the present claim 36 includes "determining by iteratively processing the present location and the plurality of target areas that whether the present location is within the target area of the-at-least-one two or more of the plurality of target locations utilizing a processor of the wireless communications device, wherein the maximum number of iterations is equal to the aggregate number of target locations having a target range." The Office Action cites Schlager as the only reference teaching these limitations. Thus if Schlager fails to describe these limitations, combining Schlager with the other references including Hollenberg, Leapman, and Devitt will fail to cure the defect of Schlager.

### 2. Reasonable Expectation of Success

Further, the modification of Schlager with the teachings of Hollenberg, Leapman, and Devitt fail to point to the reasonable expectation of success in light of the amended claims, which is the second requirement of the obviousness analysis. Thus the relevant limitations of claim 36, renders the combination moot.

### 3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. Applicant asserts that the combination of the references do not anticipate the amended claims.

For example, independent claim 36 as amended, describes that the user stores a plurality of target ranges in the memory, and also requires determining by iteratively processing the present location and the plurality of target areas that the present location is within the target area of two or more of the plurality of target locations utilizing a

processor of the wireless communications device, wherein the maximum number of iterations is equal to the aggregate number of target locations having a target range.

The examiner cites Schlager (col. 12, lines 16-48 and col. 15, lines 1-16) for describing the process of "determining whether the present location is within the target area of at least one target location utilizing a processor of the wireless communication device." However Schlager fails to disclose the limitation of amended claim 36. For example, Schlager describes the target ranges as the separation distance between the remote unit and a base station and that the separation distance is inversely proportional to the received field strength. Whether or not the remote unit is within or out of the separation distance is determined by a comparator that compares the received field strength with a predetermined limit and produces an output signal. The sign of the output signal indicates the field strength of the remote unit. A negative sign indicates that the field strength is below the limit suggesting that the remote unit is within the separation distance based on proportionality. Independent claim 36 as amended is not based on the proportionality as described by Schlager, instead claim 36 describes "determining by iteratively processing the present location and the plurality of target areas that the present location is within the target area of two or more of the plurality of target locations utilizing a processor of the wireless communications device, wherein the maximum number of iterations is equal to the aggregate number of target locations having a target range."

In fact in order to accomplish the field strength as a proportion of separation requires some pre-determination of field strength of the remote unit at various distances to determine the separation distance of the remote unit as a proportion of the field strength. Also other considerations for example the strength of battery power of the

remote unit will have to be factored into the comparator calculation. Thus Schlager fails to describe the limitations of claim 36. Also the combination of Schlager, Hollenberg, Leapman and Devitt fail to cure the defects of Schlager.

Additionally, claim 36 contemplates that target ranges may overlap and thus the present location of the device is determined to be within two or more target ranges. This is not disclosed by any of the prior art references.

#### 4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the prior art of record.

#### B. Independent Claims 38, 45, 56, and 63

Independent claims 38, 45, 56, and 63 are also presently in condition for allowance for the same reasons set forth with respect to independent claim 36. Specifically, each of claims 38, 45 and 63 requires that the present location be within the target range of two target locations. Additionally, claim 56 requires that the present location be within two target ranges of a single target location. None of the cited references disclose these features and applicant asserts that the claims are presently in condition for allowance.

C. Rejection of Claims 45-49, 53-55 and 63 Under 35 U.S.C. 102

Claims 45-49, 53-55 and 63 are rejected under 35 U.S.C. 102(e) as being unpatentable over US Patent No. 6,198,390 issued to Schlager. Given that claim 45 and 63 have similar limitations as claim 36, for at least the reasons similar to those described in section 3 of the obviousness test illustrating that Schlager fails to teach all of the limitations of claim 36, it is respectfully submitted that claims 45 and 63 are not anticipated by Schlager. Given that dependent claims 46-49 and 53-55 depend from independent claims 45, at least for the reasons similar to those discussed above, it is respectfully submitted that claims 46-49 and 53-55 are not anticipated by Schlager. Withdrawal of the rejections is respectfully requested.

D. Dependent Claims 50-52

Given that dependent claims 50-52 depend from independent claims 45, at least for the reasons similar to those discussed above, it is respectfully submitted that claims 50-52 are not obvious with respect to the cited references. Withdrawal of the rejections is respectfully requested.

E. Conclusion

For all the foregoing reasons, an early allowance of claims 36-63 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

Dated: April 23, 2008

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